REMARKS

Claims 1-16 are rejected under 35 U.S.C. § 103(a). Claims 1-16 have been canceled without prejudice, and new claims 17-36 have been added. Based on the following, Applicant contends that all pending claims are allowable, and reconsideration of the pending claims is respectfully requested. No new matter has been added. In this document, the term "Office Action" refers to the Office Action mailed July 9, 2003, unless otherwise specified.

Changes to the Claims:

To more clearly define the scope of the present invention, claims 1-16 have been cancelled without prejudice, and new claims 17-36 have been added. The new claims include limitations closely related to those in the cancelled claims. Accordingly, Applicant believes that no new search is required. Substitution of the new claims for the old claims was made to provide greater clarity and consistency of the claim terms and to more succinctly define the scope of the invention. The changes thereby advance the prosecution of this application by permitting the claimed invention to be more easily understood and by permitting the patentability of the current invention over the prior art to be more concisely and clearly demonstrated.

In the following discussion of support for the new claims, the page and line numbers refer to the originally filed specification. No new matter has been added. New independent claims 17 and 30 are supported on pages 4-6. Claims 18 and 19 are supported on page 4, line 24, and page 6, lines 11-12. Claim 20 is supported on page 4, lines 12-13. Claims 21-23 are supported on page 12, lines 20-21. Claims 24 and 36 are supported on page 8, lines 7-8. Claim 25 is supported on page 4, line 15. Claim 26 is supported on page 6, line 14. Claim 27 is supported on page 4, line 23. Claim 28 is supported on page 8, line 17. Claim 29 is supported on page 8, line 23. Claim 31 is supported on page 8, line 7, and page 11, lines 12-13. Claim 32 is supported on page 5, second paragraph. Claim 33 is supported on page 5, lines 2-3. Claim 34 is supported on page 4, lines 21-25. The limitations of claim 35 are supported on page 4 ("presenting", "selecting"), on page 5, lines 2-3 ("displaying"), on page 4, line 24 ("customizing"), on page 11, lines 12-13 ("randomly entering"), and on page 8, line 7 ("playing").

Rejection under 35 U.S.C. § 103(a):

Claims 1, 6, 8, and 10-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas et al. (U.S. Patent No. 6,190,255 hereafter Thomas) in view of Joshi (U.S. Patent No. 6,485,367 hereafter Joshi). Claims 1, 6, 8, and 10-13 have been cancelled without prejudice, and the rejection thereof is therefore considered moot.

Rejection under 35 U.S.C. § 103(a):

Claims 2-7, 9, and 14-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Joshi, further in view of the Trivial Pursuit Millennium Edition (hereafter TPME). Claims 2-7, 9, and 14-16 have been cancelled without prejudice, and the rejection thereof is therefore considered moot.

Patentability of the New Claims:

New claims 17-35 are patentable over the prior art. While the rejection cites Thomas as a reference, the rejection also recognizes that Thomas does not teach important aspects of the claimed invention which are re-stated in the new claims. There is no teaching in Thomas of the three method steps in new claims 17, 30, and 35 of "presenting . . . ," "selecting . . . ," and "customizing . . . ." The rejection uses Joshi to provide these missing method steps under 35 U.S.C. § 103. Yet, Joshi does not provide such teachings. Joshi represents an entirely different invention. In the claimed invention, the player (not the CPU) determines modifications to be made to bonus game play in advance of play. In contrast, in Joshi, the CPU responds, in a programmed learning mode, to player game play during play and changes advice to be provided to the player from the CPU in a subsequent play of the game, for instance, by changing suggestions as to what cards to hold in a draw poker game. This substantial difference between the claimed invention and Joshi is explained next.

New independent claim 17 recites the following limitations: "presenting to a player in a display of said casino game of chance, before play of said bonus game, a plurality of options for said play of said bonus game", "selecting, by the player, at least one of said plurality of presented options", and "customizing said bonus game play according to said selected at least one presented option". New independent claims 30 and 35 recite similar limitations and

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further limit the timing of the "presenting" step to being "before play of said base game". Joshi does not teach or suggest these limitations.

The following discussion compares the new claims to three gaming functions discussed in Joshi. These Joshi gaming functions are discussed herein because the Office Action refers to them, on page 3, in rejecting related limitations in now-cancelled claims. The pertinent gaming functions are conventional game play within the base game of Joshi, a player-selectable strategy option within the bonus game of Joshi, and a Central Processing Unit (CPU)-driven parameter adjustment occurring in between plays of Joshi's game of chance.

The first of the above gaming functions set forth in the rejection is conventional play in the base game of Joshi which leads to a random selection, by a CPU, of a game outcome from a plurality of possible outcomes (for example in Fig. 2a, the player choosing to hold the two Queens). See col. 3, lines 28. This is not the claimed "selecting . . ." step, but mere game play. The CPU may also trigger a bonus game in response to this player input. See col. 3, lines 57-58. The foregoing steps of Joshi are notoriously well known operations in the gaming art and do not teach or suggest customizing the bonus game play based on the player input. Accordingly, Joshi's discussion of the "player input" does not teach or suggest the bonus game customization of Applicant's new claims. In Joshi, and with reference to Figure 2a, the CPU suggests that the player "hold" the two pair. But, the player declines to follow this suggestion (see Figure 2b), and the CPU learns from the actual player selection. Later, two pair are again displayed in a subsequent play of the game (to the same player), and this time, the CPU suggests that the player hold the "face card" pair. Thus, Joshi learns (while observing conventional game play input) to change its play suggestions. The player has no control whatsoever over this changed game parameter. This contrasts with the claimed invention wherein the player is presented with clear choices, the player then selects one of the choices, and when the bonus game is entered, the bonus game is played according to the player's selection.

The second of the above gaming functions set forth in the rejection involves player-selectable strategy options (PSSOs) which are employed within, and form an integral part of, the bonus game play of Joshi. These PSSOs enable a player to select an initial bonus amount and

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to then either keep this amount or decline it and gain the ability to select another strategy option in the hope of winning a greater bonus amount. See col. 3, line 62 to col. 4 line 2. Clearly, the PSSOs of Joshi constitute the play itself of Joshi's bonus game rather than the bonus game customization recited in Applicant's new claims. Moreover, Joshi's PSSOs are necessarily made available to the player <u>during</u> bonus game play and therefore do not teach or suggest the limitations of claim 17 which claim presents options to a player "<u>before</u> play of <u>said bonus game</u>" or the limitations of claims 30 and 35 which claims both present options to a player "<u>before</u> play of <u>said base game</u>". Accordingly, Joshi's presentation and selection of PSSOs do not teach or suggest the limitations of Applicant's new claims.

The third of the above gaming functions set forth in the rejection is the adjustment of parameters, by a CPU, of future plays of Joshi's casino game of chance. It is noted here that by the word "play," Joshi refers to one full cycle through the game of chance. Specifically, Joshi recites: "After the current <u>play</u> is completed, the player may discontinue play and cash out . . . . . Alternatively, the player may place another wager and initiate <u>another play</u> of the game . . ." (emphasis added). See col. 4, lines 3-6. Clearly, the need to place another wager indicates that another full cycle of the game of chance is being initiated.

With respect to adjusting parameters of the game, Joshi recites: "In accordance with the present invention, based on the player's selections during one or more <u>previous</u> plays, the <u>CPU</u> <u>learns</u> from the player's selections <u>by adjusting</u> one or more parameters of the game for <u>future</u> plays" (emphasis added). See col. 4, lines 14-17. Joshi's "parameter adjustment" differs from Applicant's methods in two principal respects.

First, in Joshi, it is the CPU rather than the player that adjusts "one or more parameters of the game." This CPU parameter adjustment therefore does not teach or suggest Applicant's limitation of "selecting, <u>by the player,</u> at least one of said plurality of presented options".

Second, Joshi only discloses adjusting parameters of a game-of-chance play subsequent to the play in which the pertinent player selection was received. See col. 4, lines 13-16. Joshi also indicates that such future plays are initiated by placing an additional wager. See col. 4, lines 5-7. Thus, Joshi only discloses an arrangement in which: a CPU-driven parameter adjustment, based on a player input, occurs in one play of the game of chance; a wager is provided to the machine of Joshi to initiate a subsequent play of the game of chance; and the

parameter adjustment is then implemented in subsequent plays of the game of chance. This arrangement clearly differs from Applicant's claims. Accordingly, the adjustment of one or more parameters of a future play of the game of chance of Joshi, by a CPU, does not teach or suggest the limitations of Applicant's new claims. For the foregoing reasons, new claims 17-36 are patentable over the prior art.

The rejection relies on TPME for trivia questions and answers, choosing categories and the difficulty of questions. This is well known prior art, but this reference does not overcome the deficiencies of Thomas or Joshi as set forth above. Accordingly, independent claims 17, 30, and 35 are patentable over the combination of Thomas, Joshi, and TPME.

Dependent claims 18-29, 31-34, and 36 depend from claims 17, 30, and 35 respectively, inherit all the limitations of their respective independent claims, and are therefore patentable over the prior art for the same reasons as their respective independent claims. Moreover, the dependent claims recite further novel, nonobvious limitations not taught or suggested by the prior art. Accordingly, claims 17-36 are patentable over the prior art. A discussion of a selection of the dependent claims follows.

Claims 18 and 19 recite customizing "all of said bonus game play" and "only a subset of said bonus game play," respectively. Joshi only teaches "learning" to modify future bonus game play based on current game play. Moreover, Thomas and TPME are silent with respect to teaching customization of either all or a subset of bonus game play. Accordingly, claims 18 and 19 recite patentable features in addition to those they inherit from claim 17 from which they depend.

Claims 20-23 further limit claim 17, reciting different stages of the casino game of chance at which the "presenting" and "selecting" occur: "before play of the base game" in claim 20, "during play of the base game" in claim 21, "after play of the base game" in claim 22, and "upon entry into said bonus game" in claim 23. These limitations are not found in Thomas, Joshi, or TPME. In Joshi, the CPU must "learn" in some previous play of the game of chance to modify a current bonus game. Joshi's approach thus does not teach or suggest a stage of progress within a current play of a casino game of chance at which options for bonus game play are "presented" and "selected." Moreover, Thomas and TPME, in addition to not disclosing the "presenting" and "selecting" limitations in general, also do not teach or suggest the various

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stages of a casino game at which such "presenting" and "selecting" occur. Therefore, claims 20-23 recite patentable features in addition to those they inherit from claim 17 from which they depend.

Claim 27 defines the limitation "modifying at least one triggering symbol displayed during play of said base game in accordance with said selected at least one presented option." Claim 28 defines the related limitation of "making said at least one triggering symbol thematic with said selected at least one option." Claim 34 defines the limitation "modifying a color of a triggering symbol in accordance with said selected at least one option." On page 4, the Office Action admits that Thomas and Joshi do not disclose the triggering symbol modifications recited in these claims. Moreover, TPME is silent with respect to "triggering symbols" and is therefore necessarily silent with respect to modifying the colors or themes of such symbols or the symbols themselves. Accordingly, the applied art does not teach or suggest the limitations of claims 27, 28, and 34. Thus, claims 27, 28, and 34 recite patentable features in addition to those they inherit from their respective independent claims.

Claim 32 defines the limitation "wherein said presenting comprises presenting a plurality of wedges of a circle to said player and wherein said selecting comprises selecting, by the player, at least one of said plurality of wedges." The Office Action, on page 4, admits that Thomas and Joshi do not disclose these limitations but asserts that TPME provides the pertinent teachings on page 3, lines 1-10. While the cited portion of TPME discloses changing the color of the backgrounds and the existence of "cute images and animations," there is no disclosure of presenting wedges for selection by a player. Accordingly, TPME does not teach or suggest the limitations of claim 32. Claim 32 therefore recites patentable features in addition to those it inherits from claim 30 from which it depends.

Claim 33 defines the limitation "displaying said selected at least one presented option for said bonus game play to said player during said base game play." TPME is silent with respect base game play, bonus game play, and options for bonus game play. The Office Action admits that Thomas does not disclose depicting (or "presenting") aspects for playing a bonus game and allowing the player to select one of the depicted aspects. Moreover, Joshi is silent with respect to displaying a selected option for bonus game play during a base game. In Joshi, the CPU may change a parameter of a bonus game based on player activity in a previous play of the

game of chance. And, the changed parameter may cause advice, visible to the player, to differ from that provided in a previous game, such as by changing the advice regarding which cards to hold in draw poker. However, this advice would be visible only during the play of the affected game, in this case the bonus game, and not during the play of a preceding game, such as the base game. Accordingly, the applied art does not teach or suggest the limitations of claim 33. Claim 33 therefore recites patentable features in addition to those it inherits from claim 30 from which it depends. In view of the foregoing, new claims 17-36 are patentable over the prior art.
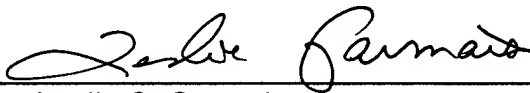
Conclusion:

In view of the foregoing, Applicant contends that all pending claims are allowable and respectfully requests that the instant application be passed to issue. Should there be any questions regarding this matter, the examiner is requested to call the below-listed attorney. A check has been submitted to cover fees due in connection with this filing. However, if additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

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Date: 10-27-2003   By: _____

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